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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,955	01/25/2001	Stephen R. Carlson	CARLSON#1(CIP)(CIP)	9807

7590 04/26/2002

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EXAMINER

KLEBE, GERALD B

ART UNIT	PAPER NUMBER
3618	

DATE MAILED: 04/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
09/768,955

Applicant(s)

Carlson

Examiner  
Gerald Klebe

Art Unit  
3618



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Jan 25, 2001

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). *GKlebe 19 Jan 02*

### Attachment(s)

15)  Notice of References Cited (PTO-892)

18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Acknowledgment***

1. Acknowledgment is given to applicant's claim for priority based on continuation from earlier applications

### ***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Specification***

3. The disclosure is objected to because of the following informalities:  
page 18, line 12: the patent number "5004654" seems to be incorrect since it relates to a patent in a class 429 (Batteries) inappropriate to the invention disclosed.

Clarification or correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris (US 4871337).

a Harris discloses a combination board (10), binding (58 and 76) and mount (52) comprising:

a board (10) having a center-line wherein the board has a channel (28) longitudinally extending along the center-line (refer col 2, lines 51-53);  
a rail (34) disposed in the channel and fixedly coupled thereto (refer col 2, line 61-65) wherein the rail is a flexible member (refer col 2, lines 66, 67) and has a key-slot (30) and two series of parallel notches (the notches best seen in Fig 3, the upper being designated 38, the lower being unnumbered);

a disc (48) rotatably coupled to the binding base plate (note the rotated positions shown in Figs 6 and 7); and

a locking mechanism (32) securely coupling the rail to the disc (refer Fig 5, and col 4, line 22 to col 5, line 35).

b. Harris discloses the claimed invention except Harris lacks explicit disclosure of a binding base plate disposed on the board. Instead, Harris uses a design wherein the disc is disposed and connected to the board without the use of an intervening base plate element.

c. However, it would have been obvious to one having ordinary skill in the art at the time the instant invention was made to have incorporated an additional structural element such as the claimed binding base plate disposed on the board between the board and the disc and coupled

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to the disc to provide additional structural strengthening, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,189,899 B1.

a. Since the claim recitation of the instant application as regards the rotatable disc and its connection to the board is more broadly stated than it is in the claim language of the reference patent in regard to the limitations of the rotatable disc element, it is clear that the limitations of the claim of the instant application, being more broadly recited, and thus included in the claim recitations of the reference patent, are already provided the protection of the reference patent. Furthermore, there is no apparent reason why applicant was prevented from

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presenting a claim corresponding to that of the instant application during prosecution of the application which matured into a patent; and

b. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences, identified below, represent obvious modifications that one of ordinary skill in the art at the time the invention was made would have been able to discover based on routine experimentation to determine the optimal or working ranges recited in the limitations of the instant invention. In particular, the claim of the instant application in referring to the rotatable disc recites "... a disc being rotatably coupled to said binding base plate...", whereas the reference patent claim 1, subpara. d. relative to the disc recites the further limitations of the "...disc having a center-line and a bottom surface on which a bar is disposed about said center-line thereof and fixedly coupled thereto whereby said bar engages and opposing pair of said series of parallel notches of said rail, said disc being rotatably coupled to said binding base plate...". These recitations of the reference patent as related to the connection of the disc to the board via its connection with the rail, represents simply an additional structural element that the claim of the instant application does not recite but which would have been obvious to one having ordinary skill in the art at the time the instant invention was made to have incorporated an additional structural element, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184. Regarding the recitation of the claim of the reference patent "...whereby said bar engages an opposing pair of said series of parallel

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notches of said rail..." it has been held that the functional "whereby" statement does not define any structure and accordingly can not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

***Prior Art made of Record***

8. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure; the prior art of Hottel teaches a skiboard, bindings and mount having a longitudinal channel along its center-line and two series of parallel notches; Crainich shows skis that use longitudinal channels along the centerline of the board; Gillis teaches a board with central longitudinal channel used in mounting rotatably mounted bindings secured to the board by rotatably coupled discs and a locking mechanism securing the disc to the channel; Ott teaches a gliding board with longitudinal channels having two series of parallel notches whereby bindings are rotatably and longitudinally adjustably and securely mounted to the board; Partridge shows a snowboard with parallel longitudinally oriented channels used in mounting bindings having discs secured to the channels; Koehler et al. teach a snowboard wherein the bindings are rotatably and adjustably mounted and locked to elongate bars that can be oriented longitudinally or at angles to the centerline of the board; Fardie teaches a rotatably mounted snowboard binding wherein the disc is mounted to a strap which is affixed to the board along its longitudinal centerline; Riedel teaches a board wherein the bindings are rotatably and longitudinally adjustably mounted to a bar affixed to the board centerline and wherein the bindings are mounted with cushioning springs to absorb longitudinal shock and vibration during boarding. These references also teach various

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other structures having features in common with some of the limitations disclosed in the instant application.

***Conclusion***

9. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 703-305-0578, facsimile 703-305-0578, 8:00 AM- 4:30 PM ET, Mon.- Fri., or to Supervisory Patent Examiner Brian L. Johnson, Art Unit 3618, at 703-308-0885.

*gk*  
gbklebe / AU 3618 / 19 April 2002

*Brian L. Johnson*  
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4/12/02